

REMARKS

Claims 32, 32, and 38-54 remain pending in this application.

OATH OR DECLARATION

The Examiner is respectfully directed to the Decision According to Status Under 37 CF 1.47(a), attached hereto, granting the Applicants' Request for Consideration of Petition Under 37 C.F.R. § 1.47(a). In light of said Decision, the Examiner is respectfully requested to withdraw the objection to the Oath/Declaration.

102(e) Rejection under *Bunker*

The Examiner rejected claims 31, 32, and 38-54 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,311,299 (*Bunker*). Applicants respectfully traverse this rejection.

Applicants respectfully assert that *Bunker* does not teach, disclose, or suggest all of the elements of claim 31 of the present invention. For example, *Bunker* discloses a plurality of data masking circuits, DM1, DM2, that are coupled to particular arrays, A1 and A2. See, Figure 2, column 4, lines 14-19. Claim 1 calls for masking at least one of the data lines that was masked based upon matching a predetermined pattern. In contrast, the masking function disclosed by *Bunker* merely receives an array of data for each masking circuit, wherein the data lines called for by claim 31 of the present invention, where one or more of the data lines is masked based

upon an enable signal. Therefore, the disclosure of **Bunker** does not read upon all of the elements of claim 31.

Furthermore, the function performed by the compression circuits DC1-DC8 disclosed by **Bunker** all receive a respective bit of read data that is applied on the data above from each of the arrays A1-A8. See, column 5, lines 29-31. The compression circuits DC1-DC8 makes a determination whether each of the bits applied upon its inputs has the same binary value and generates an error signal E1-E8 in response. See, column 5, lines 31-35. **Bunker** discloses that if any of the applied read data bits applied to the compensation compression circuit DC1-DC8, has a binary value different from that of the other applied data bits, the error signal is generated. In contrast to **Bunker**, the compression circuit called for by claim 31 of the present invention calls for detecting a predetermined pattern on a subset of data lines and to provide a pass signal when the predetermined pattern is detected on the subset of data lines. Therefore, **Bunker** does not disclose performing the detection of the predetermined pattern as called for by claim 1 of the present invention.

Bunker merely discloses comparing the binary value of the bits of the compensation circuit DC1-DC8 to determine whether they are equal in value, therefore, the predetermined pattern detection is not performed or disclosed by **Bunker**. Hence, another aspect of the elements of claim 1 are not disclosed, taught, or suggested by **Bunker**. **Bunker** discloses that in the masking mode, which is the mode used to read upon the claims of the present invention, when the data bit from the masking circuit is masked, the compression circuit compares the binary value of the bits from all other masking circuits and generates an error signal in response

to this comparison. This is performed for individual masking circuitry and compression circuits. *See*, column 7, lines 2-6. It is clear that the system of **Bunker** discloses comparing binary values from other masking circuits by the compression circuit to generate an error signal. In contrast, claim 31 calls for detecting a predetermined pattern on a subset of data lines to determine whether a pass signal is to be provided based upon comparison to a predetermined pattern. This is not taught, disclosed, or suggested by **Bunker**, which relies on comparing binary values of each bit applied to the inputs of the compression circuits DC1-DC8 to determine that an error signal is asserted. Therefore, **Bunker** does not disclose, teach, or suggest, all of the elements of claim 1 of the present invention.

In contrast to **Bunker**, claim 31 calls for compressing the masked data to determine if the masked data actually matches a predetermined pattern. **Bunker** discloses that the test circuitry operates during a first test mode to compress test data from a plurality of memory cell arrays to generate an error signal. **Bunker** does not disclose compressing mask data if the mask data matches a predetermined pattern. **Bunker** discloses that data compression circuits include circuitry to compare each of the read data bits to see if it has a binary value different from that of other applied read data bits. However, **Bunker** does not disclose compressing the masked data to determine if the mask data matches a predetermined pattern.

The Examiner cites column 5, lines 54-57 in **Bunker** to assert that it teaches that the masked data is compressed within the compression circuit DC1-DC8 by comparing each of the applied read mask bits to a predetermined value to determine if the applied read matches the predetermined value. However, Applicants respectfully assert that column 5, lines 54-57,

discloses that the data compression circuits may include circuitry to compare each of the applied read data bits to a corresponding predetermined value, which may then be used to generate an error signal. However, **Bunker** does not disclose compressing the mask data to determine if the mask data matches the predetermined pattern. **Bunker** provides data into different arrays A1-A8 into the masking circuit. In contrast, claim 31 calls for latching data present on a subset of plurality of data lines and masking the data, wherein each masking circuit is provided an array of data according to **Bunker**, which is not taught or suggested by **Bunker**. Furthermore, claim 31 calls for compressing the masked data to determine if the masked data matches the predetermined pattern to provide a pass signal if there is a match. **Bunker** does not disclose compressing the masked data to determine if the masked data matches a predetermined pattern. **Bunker** merely discloses that the data compression circuit examines whether the binary value of a read bit is different from that of another read bit. Therefore, all of the elements of claim 31 are not disclosed, taught, or suggested by **Bunker**.

Applicants respectfully also assert that the disclosure of **Bunker** also provides for compressing the unmasked bit to sequentially generate each error signal. See, for example, claim 7 of **Bunker**. Therefore, in contrast, claim 31 calls for compressing the masked data to determine if the masked data matches the predetermined pattern. Therefore, **Bunker** seems to indicate the opposite of compressing the masked data, as called for by claim 31 of the present invention, since **Bunker** discloses compressing the unmasked bit. Accordingly, all of the elements of claim 31 are not disclosed, taught, or suggested by **Bunker**. Additionally, claim 38 provides for a means plus function apparatus claim that calls for means for performing the

similar function(s) described previously. Therefore, it is not taught, disclosed, or suggested by **Bunker**. Therefore, claim 38 is also allowable for at least the reasons cited above.

Independent claims 31 and 38, are allowable for at least the reasons cited above. Additionally, dependent claims 32, and 39-54, which depend from independent claims 31 and 38, respectively, are also allowable for at least the reasons cited above.

102(f) Rejection under Bunker

The Examiner rejected claims 31, 32, and 38-54 under 35 U.S.C. § 102(f). The Examiner rejected claims 31, 32, and 38-54 because the Examiner asserted that the current invention is fully disclosed in **Bunker**. Applicants respectfully traverse this rejection. As described above, **Bunker** does not disclose all of the elements of claims 31 and 38; for example, **Bunker** does not disclose compressing the masked data to determine if the masked data matches a predetermined pattern. Claim 31 calls for compressing the masked data to determine if the masked data matches a predetermined pattern, wherein **Bunker** is directed to a test circuitry that operates during a first test mode to compress test data from a plurality of memory cell arrays to generate an error signal. Further, **Bunker** discloses compressing an unmasked bit, wherein claims 31 and 38 call for compressing a masked bit, which is yet another example of the reasons why **Bunker** does not anticipate claims 31 and 38 of the present invention. Other examples of the reasons why **Bunker** does not disclose all of the elements of claims 31 and 38 are provided above in the previous section. Therefore, claims 31 and 38 are allowable for at least the reasons cited above.

Independent claims 31 and 38, are allowable for at least the reasons cited above. Additionally, dependent claims 32, and 39-54, which depend from independent claims 31 and 38, are also allowable for at least the reasons cited above.

Obviousness-Type Double Patenting Rejection

The Examiner rejected claims 31, 32, and 38-54 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-32 of U.S. Patent No. 6,311,299. In the interest of expediency, Applicants have included herein a Terminal Disclaimer with respect to U.S. Patent No. 6,311,299 and respectfully request that the Examiner's rejection of claims 31, 32, and 38-54 be withdrawn. However, it will be appreciated that the filing of the terminal disclaimer to obviate the Examiner's rejection is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. vs. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed Cir. 1991). See MPEP §804.03. Applicants respectfully request the rejection of these claims be withdrawn.

Reconsideration of the present application is respectfully requested.

In light of the arguments presented above, Applicants respectfully assert that claims 31, 32, and 38-54 are allowable. In light of the arguments presented above, a Notice of Allowance is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the **Examiner is requested to call the undersigned attorney** at the Houston, Texas telephone

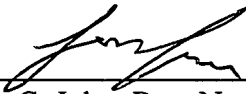
number (713) 934-4069 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON, P.C.
CUSTOMER NO. 23720

Date: October 8, 2004

By: _____


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IN THE DRAWINGS

Applicants acknowledge that the Examiner has accepted the drawings filed on November 13, 2003.



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JUL 22 2004

OFFICE OF PETITIONS

In re Application of
Todd A. Merritt et al.
Application No. 10/712,150
Filed: November 13, 2003
Attorney Docket No. 2008.001982

JUL 26 2004
DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the renewed petition filed under 37 CFR 1.47(a) on June 29, 2004 (certificate of mail date, June 21, 2004).

The petition is GRANTED.

The above-identified application was filed on November 13, 2003. The application names Todd A. Merritt and Nicholas VanHeel but the oath or declaration filed upon application was not executed by Mr. VanHeel. Accordingly, on February 12, 2004, a "Notice To File Missing Parts of Application" was mailed, requiring, *inter alia*, an executed oath or declaration, and a surcharge for its late filing. A two month period for reply was set.

In response, on February 27, 2004, a petition was filed. Petitioners asserted that diligent efforts were used to locate Mr. VanHeel and show that Internet searches as well as directory assistance searches were conducted, that correspondences were sent to addresses in Idaho and Connecticut but Nicholas VanHeel had not contacted them to confirm that the addresses used were in fact proper addresses for the intended joint inventor. The petition was dismissed in a decision mailed April 21, 2004 because the last known address of Mr. VanHeel had not been provided.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). In view thereof, this application is hereby accorded Rule 1.47(a) status.

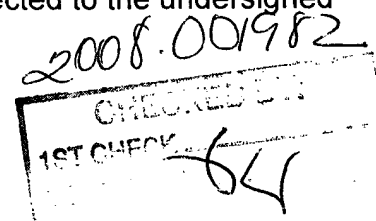
In response to the decision dismissing the petition filed February 27, 2004, a statement regarding the last known address has been provided and proof of a subsequent unsuccessful attempt to deliver correspondence to Mr. VanHeel at that address.

Thus, as provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventors at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application will be forwarded to Technology Center 2133 for further examination.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (703) 305-4497.

Patricia Faison-Ball
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Senior Petitions Attorney
Office of Petitions



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JUL 22 2004

OFFICE OF PETITIONS

In re Application of
Todd A. Merritt et al.
Application No. 10/712,150
Filed: November 13, 2003
Title of Invention: COMPRESSION CIRCUIT
FOR TESTING A MEMORY DEVICE

Dear Mr. Van Heel:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned Petitions Attorney at (703) 305-4497. Requests for information regarding your application should be directed to the File Information Unit at 703/308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 703/308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc:

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